

Application No.: 09/972772

Docket No.: PPI-106CP

REMARKS

Claims 1-43 and 45-48, 50-61 were pending in the application. Claims 15, 28, 37, 38 and 48 have been amended. Accordingly, upon entry of the amendments presented herein, claims 1-43, 45-48, and 50-61 will remain pending.

Support for the amendments to the claims may be found throughout the specification and claims as originally filed. Specifically, support for the amendment to claim 15 may be found in, for example, claim 20 as filed.

Cancellation of and/or amendments to the claims as originally filed should in no way be construed as an acquiescence to any of the rejections/objections set forth in the instant Office Action, and were made solely to expedite prosecution of the above-identified application. Applicants reserve the right to pursue the claims as originally filed, or similar claims, in one or more patent applications. No new matter has been added.

Objection to the Disclosure

The Examiner has objected to the disclosure and has requested that the serial number and filing date of the parent application be inserted into the priority claim. Accordingly, Applicants have amended the priority claim to include the serial number and filing date of the parent application, thereby rendering this objection moot.

Objection to the Claims

The Examiner has objected to claims 28 and 37 requesting that the semicolon after SEQ ID NO:16 be deleted. Applicants have amended claims 28 and 37 to remove the semicolon, thereby rendering this rejection moot.

The Examiner has also objected to claim 38 and claim 48 because the parenthesis before "3-" does not match the bracket after "enyl". Applicants have amended claims 38 and 48 accordingly, thereby rendering this objection moot.

Application No.: 09/972772

Docket No.: PPI-106CP

Rejection of Claims 15-19 Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 15-19 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner is of the opinion that "[t]here is no original disclosure supporting the limitation inserted into claim 15 that D can be cyclic alkyl without limitation on the size of the alkyl. The original disclosure limits such cyclic alkyl groups to cyclic C1-C6 alkyl groups."

While in no way acquiescing to the validity of the Examiner's rejections and solely in the interest of expeditious prosecutions, Applicants have amended claim 15 to limit the cyclic alkyl groups to C1-C6 alkyl groups, thereby rendering this rejection moot.

Provisional Rejection of Claims 1-43, 45-48, and 50-61 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-43, 45-48, and 50-61 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-65 of co-pending Application No. 10/001,945. In particular, the Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the claimed active agents of the '945 application with pharmaceutically acceptable carriers."

While in no way admitting that claims 1-43 45-48, and 50-61 of the present application are obvious over claims 1-65 of co-pending Application No. 10/001,945, upon allowance of the '945 application, Applicants will consider submitting a terminal disclaimer in that application in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate this rejection.

Provisional Rejection of Claims 1-38 and 50-58 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-38 and 50-58 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-58,

Application No.: 09/972772

Docket No.: PPI-106CP

60, 62, 71 and 74-84 of co-pending Application No. 10/138,935. In particular, the Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the claimed active agents of the '935 application with pharmaceutically acceptable carriers."

While in no way admitting that claims 1-38 and 50-58 of the present application are obvious over claims 20-58, 60, 62, 71 and 74-84 of co-pending Application No. 10/138,935, upon allowance of the '935 application, Applicants will consider submitting a terminal disclaimer in that application in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate this rejection.

Provisional Rejection of Claims 1-43, 45-48, and 50-61 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-43, 45-48, and 50-61 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-73 of co-pending Application No. 10/429,174. In particular, the Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the claimed active agents of the '174 application with pharmaceutically acceptable carriers."

While in no way admitting that claims 1-43, 45-48, and 50-61 of the present application are obvious over claims 1-73 of co-pending Application No. 10/429,174, upon allowance of the '174 application, Applicants will consider submitting a terminal disclaimer in that application in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate this rejection.

Application No.: 09/972772

Docket No.: PPI-106CP

CONCLUSION

In view of the above amendments and remarks, Applicants believe that the pending application is in condition for allowance.

Applicants believe that no fee is due with this Amendment and Response. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. PPI-106CP from which the undersigned is authorized to draw.

Dated: March 7, 2005

Respectfully submitted,

By 
Maria Laccottipe Zacharakis, Ph.D., J.D.
Registration No.: 56,266
LAHIVE & COCKFIELD, LLP
28 State Street
Boston, Massachusetts 02109
(617) 227-7400
(617) 742-4214 (Fax)
Attorney/Agent for Applicants